



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|--------------------------------------|------------------------|
| 10/810,214 | 03/26/2004 | Lisa M. Fisher | 204111-1 (5024-00337) | 8398 |
| 26753 7590 08/21/2007 ANDRUS, SCEALES, STARKE & SAWALL, LLP 100 EAST WISCONSIN AVENUE, SUITE 1100 MILWAUKEE, WI 53202 | | | EXAMINER PANNALA, SATHYANARAYAN R | |
| | | | ART UNIT 2164 | PAPER NUMBER |
| | | | MAIL DATE 08/21/2007 | DELIVERY MODE PAPER |

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

| | | | |
|------------------------------|--|--------------------------------------|--|
| Office Action Summary | Application No. 10/810,214 | Applicant(s) FISHER ET AL. | |
| | Examiner Sathyanarayan Pannala | Art Unit 2164 | |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 June 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-25 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-25 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08). Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 6/7/2007 has been entered.

Response to Amendment

2. Applicant's Amendment filed on 6/07/2007. In this Office Action, claims 1-25 are pending.

Claim Rejections - 35 USC § 101

3. 35 U.S.C. § 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

4. Claims 1-25 are rejected under 35 U.S.C. § 101, Claims 1-4 are rejected under 35 U.S.C. § 101, because claims are directed to software per se. Independent claims 1,

Art Unit: 2164

14 and 22 are claiming a computer program per se and functional descriptive material consisting of data structures and computer programs, which impart functionality when employed as a computer component. There are no physical devices specified in claims. Further, independent claims 14 and 22 are claims are indefinite and claiming a non-statutory subject matter. Therefore they are not patentable. As such, the claims are not limited to statutory subject matter and are therefore non-statutory. See *Diehr*, 450 U.S. at 185-86, 209 USPQ at 8.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

6. Claims 1-25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bianco et al. (USPA Pub. 2002/0082865A1) hereinafter Bianco, and in view of Miyamoto (Japan Patent JP02002027386A) hereinafter Miyamoto.

7. As per independent claims 1 and 14, Bianco teaches the electronically displaying files include a single electronically displayable file including a treatment pathway timeline display (page 2, paragraph [0017]). Bianco teaches the claimed, an electronic document manager including an electronic image file database for storing the electronic image files (Fig. 2B, page 5, paragraph [0089]). Bianco teaches the claimed, a task engine in communication with said electronic document management module for generating tasks related to the electronic image files based on the contents of said electronic image file events (Fig. 2A, page 5, paragraph [0087]).

Bianco does not teach generating an electronic image file events. However, Miyamoto teaches the claimed "generating electronic image file events related to the electronic image files" as the personal computer 2 (Fig. 1) generates a meta-data file corresponding to the image data file (S105).

8. As per dependent claim 2, Bianco teaches the claimed, task engine further comprises a task generator including an event manager for storing said electronic image file events, a ruleset manager including at least one predetermined set of rules, each of said rules having at least one predetermined condition, and a task generation manager for comparing the electronic image file events to said at least one

Art Unit: 2164

predetermined set of rules and generating one or more tasks if the electronic image file events meet said at least one predetermined condition (Fig. 4, page 6, paragraph [0092]).

9. As per dependent claims 3 and 15, Bianco teaches the claimed, task engine module further comprises predetermined task instructions for working each of the tasks generated that relate to the electronic image files (Fig. 2B, page 5, paragraph [0089]).

10. As per dependent claims 4 and 16, Bianco teaches the claimed, task instructions include a predetermined workflow (Fig. 2B, page 5, paragraph [0089]).

11. As per dependent claims 5 and 17, Bianco teaches the claimed, task instructions include means for linking to said electronic document manager (Fig. 4, page 6, paragraph [0094]).

12. As per dependent claims 6 and 18, Bianco teaches the claimed, linking allow the electronic image files stored in said database to be viewed in said task engine (Fig. 1, page 5, paragraph [0084]).

13. As per dependent claims 7 and 19, Bianco teaches the claimed, linking include a button control and a hypertext link (Fig. 5, page 7, paragraph [0102]).

Art Unit: 2164

14. As per dependent claims 8 and 20, Bianco and Miyamoto combined teaches claim 1 and 14. Bianco does not explicitly teach sorting or filtering electronic documents. However, Miyamoto teaches the claimed, electronic document manager includes one or more method modules for sorting or filtering particular groups of electronic image files and said means for linking is used to execute said one or more method modules (abstract). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to have combined the teachings of the cited references because Miyamoto's teachings would have allowed Bianco's method to manage separately electronic image files and their metadata files.

15. As per dependent claims 9 and 21, Bianco teaches the claimed, task engine module includes a task list including said tasks relating to the electronic image files (Fig. 2B, page 8, paragraph [0107]).

16. As per independent claim 10 and 22, Bianco teaches the electronically displaying files include a single electronically displayable file including a treatment pathway timeline display (page 2, paragraph [0017]). Bianco teaches the claimed, separating one or more electronic image file events related to the one or more electronic image files (Fig. 2A, page 5, paragraph [0087]).

Bianco does not teach sorting electronic documents and generating an electronic image file events. However, Miyamoto teaches the claimed "receiving the one or more electronic image files, sending the one or more electronic image file events to a task

engine and outputting one or more tasks if said one or more electronic image file events meets said at least one predetermined condition” as a personal computer 2 (Fig. 1) receives an image data file from an electronic still camera (Fig. 1) and records it in a recorder 22 (Fig. 1) (S101). The personal computer 2 (Fig. 1) sorts and arranges the image data file (S102). An operator selects the image data file (S103) and then selects a form data file (S104). Subsequently, the personal computer 2 (Fig. 1) generates a meta-data file corresponding to the image data file (S105). The image data file includes the names of image data file and form data file. The personal computer 2 (Fig. 1) records the meta-data file and the form data file on a CD 27 (Fig. 1) (S106). When an operator sets the CD 27 (Fig. 1) in the personal computer 2 and designates display of a reproduced image, the reproduced image is presented on a display 25 in a display layout described in the form data file (Abstract). Thus, it would have been obvious to one of ordinary skill in the data processing art at the time of the invention, to combine the teachings of the cited references because Miyamoto’s teachings would have allowed Bianco’s method to manage separately electronic image files and their metadata files.

17. As per dependent claims 11 and 23, Bianco teaches the claimed, one or more tasks include predetermined task instructions for working each of said one or more tasks (Fig. 2B, page 8, paragraph [0107]).

18. As per dependent claims 12 and 24, Bianco teaches the claimed, task instructions include a predetermined workflow (Fig. 2B, page 5, paragraph [0089]).

19. As per dependent claims 13 and 25, Bianco teaches the claimed, task instructions are adapted to link to said electronic document manager (Fig. 4, page 6, paragraph [0094]).

Response to Arguments

20. Applicant's arguments filed on 6/07/2007 have been fully considered but they are moot in view of new grounds of and details as follows:

a) Applicant's argument states as "the term 'event' to be a data file, rather than an action or occurrence" (see Remarks section, page 7, paragraph last).

In response to Applicant's argument, Examiner withdrawn the rejection of claims under 35 U.S.C. 112, 2nd paragraph.

b) Examiner modified 35 U.S.C. 101 rejection paragraphs to provide better understanding.

c) Applicant's argument states as "Bianco indeed does not teach an electronic image file event" (see page 9, paragraph one).

In response to Applicant's argument, Examiner disagrees because Newly added reference Miyamoto teaches (see attached abstract).

Art Unit: 2164

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sathyanarayan Pannala whose telephone number is (571) 272-4115. The examiner can normally be reached on 8:00 am - 5:00 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Rones can be reached on (571) 272-4085. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.


Sathyanarayan Pannala
Primary Examiner

srp
August 18, 2007